

Remarks

Claims 1-6, 9, 10, 13-18, 21-24, 27, 34-37 and 39 were pending in the subject application. By this amendment, the applicant has amended claims 1, 4, 5, and 14 and have cancelled claims 2, 3, 6, 21 and 34. No new subject matter has been added by these amendments. Accordingly, claims 1, 4-6, 9, 10, 13-18, 22-24, 27 and 35-37 are now before the Examiner for her consideration.

The amendments and cancellation of claims as set forth herein has been done in an effort to lend greater clarity and specificity to the claimed subject matter and to expedite prosecution. These amendments and claim cancellations should not be taken to indicate the applicants' agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claim now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 1-3, 5, 14, 16, 22, 34-36 and 39 have been rejected under 35 U.S.C. §102(b) as being anticipated by Scalice (U.S. Patent No. 3,596,390). The applicant respectfully traverses this grounds for rejection because the Scalice reference does not disclose or suggest the unique and effective hotel communication device of the current invention.

Please note that the Scalice reference pertains to a manual "computer" used for indicating directions for cosmetic use. Thus, the purpose of this device has no relationship at all to the current applicant's device. Moreover, there are important structural differences between the applicant's communication device and the Scalice computer. These structural differences include the manner in which information is displayed, the means for indicating choices, and the nature of the information/choices that are displayed.

Many court decisions clearly establish that rejections under 35 USC §102 are appropriate only in those instances where a single prior art reference has placed into the public domain the very invention which is claimed. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the

elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra; Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In *Dewey & Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 124 F.2d 986, 990; 52 USPQ 138 (2nd Cir. 1942).

The cited reference does not in any way place the current applicant's unique hotel communication device into the public domain. Specifically, Scalice does not appear to disclose a device having an indicator, an indicator window and an instructional window, wherein the indicator is adjacent to the indicator window, and the indicator window is adjacent to the instructional window. Scalice also does not disclose a device wherein the indicator is operatively connected to the indicator window, such that when the indicator is in a first position a positive command is displayed in the indicator window, and when the indicator is in a second position a negative command is displayed in the indicator window, and when the indicator is in a neutral position the indicator window is empty.

The messages displayed by the Scalice device are also, clearly, very different from the messages displayed by the device of the current invention. In this regard, the applicant believes that, particularly in view of the CAFC decision in *State Street*, messages that facilitate a method of doing business can add to the novel structural features of a device. As noted above, in the current case novelty is not predicated only on the unique messages; however, the applicants respectfully submit that the unique arrangement and content of the messages adds to the already significant physical differences between the current invention and the Scalice device.

Because Scalice does not disclose a device having the structural characteristics as required by the applicant's claims, the applicant's claims are not anticipated by Scalice. Accordingly, the

applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. §102(b).

Claims 4, 6, 9, 10, 15, 17, 18, 23, 24 and 37 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Scalice (U.S. Patent No. 3,596,390). Also, claims 13, 21 and 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Scalice in view of Ellis *et al.* U.S. Patent No. 3,983,649.

Initially, the applicant respectfully submits that the cited reference is improperly relied upon because it is from a non-analogous art. As expressed by the CCPA,

"[i]n resolving the question of obviousness under 35 USC §103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings from references from non-analogous arts is the realization that an inventor could not possibly be aware of every teaching in every art." *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

In this regard, the CAFC has provided clear guidance as to the art which should be considered relevant to the inventor's field of endeavor:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) — in other words, common sense — in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. . . The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *In re Oetiker*, 24 USPQ 2d 1443, 1446 (CAFC, 1992) (emphasis added).

In the current case, simple application of common sense (as suggested in the *Oetiker* opinion) leads to the inescapable conclusion that the Scalice invention is in a different field of endeavor and

hotel/cosmetics  
addresses entirely different problems than those that have been solved by the current invention. Specifically, the Scalice invention pertains to a manually operated computer used for cosmetic purposes (see abstract and column 2, lines 13-26). The Scalice reference has nothing to do with hotel services and is clearly not in a field of endeavor that would be relevant to a person trying to solve a problem in the hotel field.

A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, none of the references contain a suggestion of the applicant's unique communication device. It is only the applicant's disclosure that provides such a teaching, and the applicant's disclosure cannot be used to reconstruct the prior art for a rejection under §103. This was specifically recognized by the CCPA in *In re Spinnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The mere fact that the purported prior art could have been modified or applied in a manner to yield applicant's invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art . . . ." *In re Dow Chemical Co.*, *supra* at 1531. In the references cited in support of the §103 rejection, one finds neither.

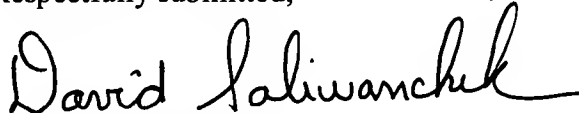
Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. §103(a).

In view of the foregoing remarks and the amendments set forth above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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